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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRIAN HUNTER OSTERGREN,  
TRISHA EILEEN STOUFFER, JONATHAN TODD DAVID, and  
GREGORY JOSEPH CANESSA

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Appeal 2018-005970  
Application 13/247,861  
Technology Center 3700

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Before JEREMY M. PLENZLER, FREDERICK C. LANEY, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s decision, filed January 11, 2017 (“Non-Final Act.”), to reject claims 1, 2, 6, 7, 9–13, 15–19, and 21–23 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more. Claims 3 and 4 have been withdrawn; claims 5, 8, 14, and 20 have been canceled. Appellant’s counsel appeared for an oral hearing on March 12, 2020. A transcript of that hearing is in the record. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Microsoft Technology Licensing, LLC. Appeal Brief (“Appeal Br.”) 2, filed July 11, 2017.

## BACKGROUND

Appellant's disclosure relates to automatically downloading digital content to a computing device. Spec. ¶ 9. This automatic downloading is summarized generally as involving the following steps. *Id.* "Digital content that is available from a remote content server is checked to determine if any digital content matches criteria specified for downloading." *Id.* After a match for a particular digital content is found, which has not been previously downloaded, the digital content is added to a download queue. *Id.* "The digital content specified in the download queue is transferred to the computing device." *Id.*

Claims 1, 17, and 18 are independent, from which the remaining claims depend. Illustrative claim 1 is reproduced below.

1. A method of obtaining new digital content on a computing device, the method comprising:
  - on the computing device, computer-recognizing that autonomously operable digital content that satisfies at least one criterion for automatic downloading is available on one or more remote content servers;
  - on the computing device, loading a history of autonomously operable digital content versions previously downloaded to the computing device;
  - on the computing device, generating a download queue of autonomously operable digital content which satisfies the at least one criterion for automatic downloading;
  - based on the history of autonomously operable digital content versions previously downloaded to the computing device, on the computing device, excluding from the download queue any new versions of autonomously operable digital content items that have been previously downloaded to the computing device; and
  - automatically downloading contents of the download queue to the computing device.

Appeal Br. 18 (Claims App.).

## JUDICIAL EXCEPTIONS

The Patent Act defines subject matter eligible for patent protection as “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. Yet the Supreme Court has “long held” that this provision contains an important implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U. S. 576, 589 (2013). These three concerns are “judicially created exceptions to § 101,” or more concisely, “judicial exceptions.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1311 (Fed. Cir. 2016). Thus, an “abstract idea” is a judicial exception to subject matter (e.g., a method) that would otherwise be deemed patent eligible under 35 U.S.C. § 101.

## THE ALICE TEST

In *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014), the Supreme Court provided a two-step test to detect when an attempt is being made to patent an abstract idea in isolation. *Id.* at 217–18. In *Alice* step one, a determination is made as to whether the claim at issue is “directed to” an abstract idea. *Id.* at 218. When analyzing a claim under *Alice* step one, attention can be given to whether an abstract idea recited in the claim has been integrated into a practical application “thereby ‘transform[ing]’ them into a patent-eligible invention.” *Id.* at 217 (referencing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 72 (2012)). While a judicial exception (e.g., an abstract idea) cannot be patented, “an *application*” of a judicial exception “to a known structure or process may

well be deserving of patent protection.” *Diamond v. Diehr*, 450 U.S. 175, 187 (1981); *see also Bilski v. Kappos*, 561 U.S. 593 (2010).

If the claim at issue is “directed to” an abstract idea, *Alice* step two must be performed. *See Alice*, 573 U.S. at 217–18. In the second step of the *Alice* test, a determination is made as to whether “additional elements” in the claim, both individually and as an ordered combination, contribute “significantly more” than the abstract idea. *Id.* When analyzing a claim under *Alice* step two, attention is given to whether additional elements, and any ordered combination thereof, are “well-understood,” “routine,” or “conventional.” *Id.* at 225.

#### 2019 § 101 GUIDANCE

The 2019 Revised Patent Subject Matter Eligibility Guidance (“2019 § 101 Guidance”) provides us with specific steps for discerning whether a claim passes the *Alice* test for patent eligibility. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019). These steps are “[i]n accordance with judicial precedent” and consist of a two-pronged Step 2A and a Step 2B. *Id.* at 52.

#### ANALYSIS

Appellant argues claims 1, 2, 6, 7, 9–13, 15–19, and 21–23 as a single group. *See* Appeal Br. 8–16. As a result, we select claim 1 as representative, and the remaining claims stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determined that the claims are directed to ineligible subject matter under 35 U.S.C. § 101. Non-Final Act. 2–4. The Examiner found independent claim 1 to be “directed to a judicial exception (i.e., a law

of nature, a natural phenomenon, or an abstract idea) without significantly more.” *Id.* at 2. According to the Examiner, the limitations of claim 1 “are directly analogous to claims of downloading customized content for an individual which has already been determined to be abstract.” *Id.* at 3 (citing *Affinity Labs of Texas, LLC, v. Amazon.com*, 838 F.3d 1266 (Fed. Cir. 2016)). In addition, although claim 1 repeatedly refers to a “computing device,” the Examiner found that that device failed to offer “significantly more” to the recited abstract idea because “the computing device has no limitations that make it anything more than a generic purpose computer.” *Id.*

Appellant contends claim 1 is “not directed to any sort of abstract idea,” but instead is “directed to an improvement in computer functionality.” Appeal Br. 10. Appellant contends “claim 1 describes a method by which a computing device can automatically download new digital content from one or more remote content servers.” *Id.* “Because downloading of digital content inherently requires expenditure of computing resources (e.g., processing cycles, network bandwidth, data storage space), [the] claimed automatic downloading is also restricted to digital content that satisfies at least one criterion for automatic downloading, and that has not been previously downloaded to the computing device.” *Id.* at 11. Appellant contends that, “[u]nlike the *Affinity Labs* claims, Appellant’s claims are directed to a specific problem that arises in the field of computer technology—namely, that automatic downloading of digital content can result in the unnecessary consumption of processing cycles, network bandwidth, and data storage space of a computing device.” *Id.* at 14. “By solving this problem, [Appellant contends that the] claims represent an

improvement to the functioning of a computer, rather than the application of computer technology to practices outside the realm of computer technology.” *Id.* Appellant contends the improvement to the functionality of a computer is derived from “provid[ing] the user easy access to new digital content . . . without unnecessarily expending computing resources to download redundant, previously-downloaded digital content.” *Id.* at 15. For the following reason, we are not persuaded the Examiner erred.

*Step 2A – Prong One*

Per the 2019 § 101 Guidance, we begin our analysis with the first prong of Step 2A (“Prong One”) where we determine whether the claim “recites” an abstract idea. 2019 § 101 Guidance, 84 Fed. Reg. at 54. The Guidance “extracts and synthesizes key concepts identified by the courts as abstract ideas,” and these concepts include “[m]ental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion).” *Id.* at 52. “If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind.” *Id.* at 52 n.14.

Software-related claims are often analyzed “by asking whether the claims focus on a ‘specific asserted improvement in computer capabilities’ instead of on ‘a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.’” *Ubisoft Entertainment, S.A. v. Yousician OY*, 2020 WL 3096369, \*2 (Fed. Cir. June 11, 2020) (quoting *Finjan, Inc. v. BlueCoat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018)). Because information is itself intangible, the Federal Circuit has “treated

collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). “In a similar vein, [it has] treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Id.* at 1354. For example, the Federal Circuit has held that tailoring the provision of information to a user’s characteristics is an abstract concept. *British Telecommunications PLC v. IAC/Interactive Corp.*, 2020 WL 2892601, \*2 (Fed. Cir. June 3, 2020) (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015); *Affinity Labs*, 838 F.3d at 1271 (Fed. Cir. 2016)). Indeed, Appellant acknowledges that the “mental process” category of the 2019 § 101 Guidance is the appropriate category for some steps in claim 1. *See, e.g.*, Tr. 5:19.

The process steps of claim 1 are directed to: (1) “recognizing . . . digital content that satisfies at least one criterion for automatic downloading is available;” (2) “loading a history of . . . digital content versions previously downloaded;” (3) “generating a download queue of . . . digital content which satisfies the at least one criterion for automatic downloading;” (4) “based on the history of . . . [the] content versions previously downloaded . . . excluding from the download queue any new versions of . . . [the] content items that have been previously downloaded;” and (5) “downloading contents of the download queue.” Appeal Br. 18 (Claims App.). These steps describe concepts normally performed in the human mind. The first step is an evaluation of what information is available. The second step is an evaluation of what information had been obtained previously. The third step

is an evaluation of what information may be requested. The fourth step is an evaluation of what information can be removed from the information that may be requested. The fifth step is to receive the resulting information for the narrowed request.

Thus, independent claim 1 recites mental processes followed to customize the retrieval of content for an individual. We agree with the Examiner that these steps, therefore, recite an abstract idea. Consequently, we proceed to the second prong of Step 2A (“Prong Two”) of the Guidance. *See id.* at 54.

#### *Step 2A – Prong Two*

In Prong Two, we evaluate whether a claim contains additional elements that “integrate” the abstract idea “into a practical application.” (*See* 2019 § 101 Guidance, 84 Fed. Reg. at 52.) “[A]dditional elements” are “claim features, limitations, and/or steps that are recited in the claim beyond the identified judicial exception.” (*Id.* at 55, n.24) Thus, the “additional elements” in independent claim 1 are those “beyond” the abstract idea of customizing the retrieval of content for an individual.

When an additional element in a claim is a “computer,” the relevant question is not whether the claim requires the computer to accomplish a recited function. *Alice*, 573 U.S. at 223. Rather, “the relevant question” is whether the claim does more than simply “instruct the practitioner to implement the abstract idea” on a computer. *Id.* at 225. The mere recitation of a computer in the claim, and/or words simply saying “apply” the abstract idea “with a computer,” will not transform the abstract idea into a patent-eligible invention. *Id.* at 223. In short, the sheer introduction of a computer into the claim is not enough to “impart patent eligibility.” *Id.*

Independent claim 1 recites a “computing device” and a “remote content server.” Appeal Br. 18 (Claims App.). These computer components are configured to “automatically” perform the customized retrieval of content using steps discussed above. Thus, claim 1 simply instructs the practitioner to implement abstract-idea-imbedded steps with a computer.

Consequently, under Prong Two of Step 2A, the additional elements in independent claim 1 do not integrate the recited abstract idea into a practical application, and we proceed to Step 2B.

### *Step 2B*

In Step 2B, we evaluate whether “additional elements recited in the claim[] provide[] ‘significantly more’ than the recited judicial exception.” *See* 2019 § 101 Guidance, 84 Fed. Reg. at 56. More particularly, we evaluate whether these additional elements “add[] a specific limitation or combination of limitations that are not well-understood, routine, conventional activity,” or whether they instead “simply append[] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.” *Id.* The additional elements must consist of something other than a conventional arrangement of conventional components to qualify as “significantly more” under the *Alice* test for patent eligibility. *Id.*

The 2019 § 101 Guidance requires us to look at independent claim 1’s additional elements not only individually, but also in combination. *See* 2019 § 101 Guidance, 84 Fed. Reg. at 54. Indeed, the Federal Circuit has held that it is possible for “an inventive concept” to reside in “the non-conventional and non-generic arrangement of known, conventional pieces,” such as “a set of generic computer components.” *Bascom Glob. Internet*

*Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016). Here, however, claim 1 does not specify any specific arrangement, operation, or coordination of the computing device and server to perform the customized retrieval beyond having them perform their conventional operations to implement the recited steps.

The Specification notably states that the computing system relied upon to describe a preferred embodiment of the invention “is but one example of a suitable computing system” and that the invention is not to “be interpreted as having any dependency or requirement relating to any one or combination of illustrated components.” Spec. ¶ 20. Appellant has failed to demonstrate how the recited steps of claim 1 change *the way* a computer operates, but instead focus on the benefits derived from simply using the computer as a tool to implement the recited steps to automate the downloading digital content. Consequently, under Step 2B, the additional elements in independent claim 1 do not provide significantly more than the recited abstract idea (customized retrieval of content). We therefore agree with the Examiner that independent claim 1 fails the *Alice* test for patent eligibility.

#### *The Appellant’s Arguments*

Appellant contends, based upon *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) and *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), that claim 1 recites patent eligible subject matter. Appeal Br. 8–13. First, Appellant contends, “like the patent-eligible claims from *Enfish*, [claim 1 is] directed to an improvement in computer functionality, and accordingly [is] not directed to any sort of abstract idea.” *Id.* at 10. Second, Appellant contends, “[s]imilar to the claims of *DDR*

*Holdings*, the claims of the instant application have nothing to do with the performance of some pre-Internet-world business practice,” but “are directed instead to practices for downloading of digital content that have no pre-Internet-world analog.” *Id.* at 13. We do not find either contention persuasive.

Appellant contends that claim 1 “improve[s] computer functionality by automating the download of digital content (e.g., computer games) to a computer.” Reply Br. 2. Notably, however, Appellant has failed to demonstrate how the recited steps of claim 1 change *the way* a computer operates, but instead focus on the benefits derived from simply using the computer as a tool to implement the recited steps to automate the downloading digital content.

In *Enfish*, the Federal Circuit held that the claims were directed to the way a computer operates because “the claims [were] not simply directed to any form of storing tabular data, but instead [were] specifically directed to a self-referential table for a computer database.” 822 F.3d at 1337. In that case, the claims recited expressly an allegedly innovative self-referential table that was “a specific type of data structure designed to improve the way a computer stores and retrieves data in memory.” *Id.* at 1339. Appellant has not persuasively shown claim 1 includes any limitation analogous to the ones in *Enfish* that changed the way a computer operates to improve its functionality. Claim 1 instead is more akin to the type of claims that *Enfish* recognized as not improving the way a computer operates because it is simply adding conventional computer components to a well-known practice (e.g., customizing a request and retrieval of information to only new information that someone has not previously received). *See id.* at 1338. The

level of generality of the recited elements in claim 1 does “no more than describe a desired function or outcome, without providing any limiting detail that confines the claim to a particular solution to an identified problem,” which the Federal Circuit has held to be confirmation that the claim is “directed to an abstract idea, not to a concrete embodiment of an idea.” *Affinity Labs*, 838 F.3d at 1269.

Similarly, we disagree with Appellant that the subject matter of claim 1 is similar to the claims in *DDR Holdings* because it is directed to practices for downloading digital content that has no pre-Internet-world analog. Claim 1 recites steps that identify what information is available, identify what information that has not been obtained previously, and retrieve that information determined to be available and new. We agree with the Examiner that such a process “is notoriously well known outside of the computer industry and thus is not an inherent problem solely related to computers.” Final Act. 5. By contrast, in *DDR Holdings*, the invention was directed specifically to avoiding a website visitor from being “instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” 773 F.3d at 1257. The claims in that case recited limitations that addressed this problem by creating a “hybrid web page that merges content associated with the products of the third-party merchant with the stored ‘visually perceptible elements’ from the identified host website.” *Id.* As a result, “the visitor is no longer transported to the third party’s website.” *Id.* In view of the differences in claimed subject matter in *DDR Holdings* and claim 1 here, we are not persuaded that Appellant’s claims are necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computers.

Thus, after careful consideration of the Appellant's arguments, we still agree with the Examiner that independent claim 1 is directed to a judicial exception without significantly more. As such, we sustain the rejection of claim 1 under § 101, including claims 2, 6, 7, 9–13, 15–19 and 21–23, which fall with claim 1.

*Summary*

We sustain the Examiner's rejection of claims 1, 2, 6, 7, 9–13, 15–19, and 21–23 under 35 U.S.C. § 101.

CONCLUSION

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 6, 7, 9–13, 15–19, 21–23	101	Eligibility	1, 2, 6, 7, 9–13, 15–19, 21–23	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED